



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,162	09/20/2001	Rodney Thomas Whisnant	10684.103	4261
24283	7590	12/29/2005	EXAMINER	
PATTON BOGGS 1660 LINCOLN ST SUITE 2050 DENVER, CO 80264			HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/960,162	Applicant(s) WHISNANT ET AL.	
	Examiner Peter K. Huntsinger	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

DOUGLAS Q. TRAN
PRIMARY EXAMINER
Tran Douglas

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 20 is objected to because of the following informalities: "Instructions for directing said photographer unit to" should be replaced with "Instructions for directing said photographer processing unit to". Appropriate correction is required.

Response to Amendment

2. The amendment filled on 06 October 2005 has been entered in full.
3. Based on the applicant's amendment, the objections to claims 4, 15, 19, 21, 22, and 25-28 have been withdrawn.

Response to Argument

4. Applicant's arguments filled on 06 October 2005 have been fully considered but they are not persuasive.

The applicant argues on pages 17 and 18 of the response that:

None of the references cited has a processing unit that does all the claimed functions.

- a. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues on pages 18 and 19 of the response that:

The references do not disclose transmitting to the photographer processing unit routing information for transmitting the digital image to the processing unit of one of the fulfillment centers on the list in the gateway processing unit.

- b. Kurokawa et al. disclose recording on the recording medium (within the photographer processing unit) the URL of the reception shop (fulfillment center) (page 2, paragraph 32).

The applicant argues on page 20 of the response that:

The routing information refers to a substitute fulfillment center, not one of the fulfillment centers maintained in the list.

- c. The list disclosed by Kurokawa et al. comprises a list of substitute fulfillment centers (Fig. 2, page 2, paragraph 28).

In Kurokawa et al., the confirmation is sent by the fulfillment center processing unit, not the photographer processing unit.

- d. The user clicks a button on the screen of the photographer processing unit to confirm (Step 47 of Fig. 2, page 2, paragraph 28).

The substitute center is determined by parameters in the server, not in the order.

- e. The connection data is recorded in the order (page 1, paragraph 19).

Kurokawa et al. disclose a confirmation by a photographer processing unit, not the reception by a gateway processor of a confirmation from the fulfillment center processing unit that an order has been processed.

- f. A fulfillment center that receives the print is displayed on the screen of the photographer processing unit. Because this occurs after the order was sent, the signal acts as a confirmation of the fulfillment center (page 2, paragraph 30).

The applicant argues on page 21 of the response that:

With respect to claims 21, 22, 64, and 65, the transmission is between the photographer processing unit and the fulfillment center processing unit, while the confirmation and communication is with the first processing unit.

- g. As shown in Fig. 1 of Kurokawa et al., the connection between the terminal (photographer processing unit) and the service shop (fulfillment center) occurs through the print receiving server (gateway processing unit).

To get the combination of Kurokawa et al. and Garfinkle et al., it is necessary to modify the combination using the present claims as a reference.

h. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant argues on pages 22 and 23 of the response that:

If Kurokawa et al., Garfinkle et al., and Jackson et al. are combined, the gateway processing unit does the function, not the fulfillment center.

i. Kurokawa et al. disclose the server (gateway processing unit) and Jackson et al. discloses the further limitations of claims 7 and 33. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is not believable that some skilled in the art would look at the four references cited.

j. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Norris reference is not in the photography field.

In response to applicant's argument that Norris is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, The references Kurokawa et al. and Norris are within the same field of computer network systems.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 15-32, 34-40, 43-49, 58-75, 77-83, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640 and Garfinkle et al. U.S. Patent 6,017,157.

Referring to claim 1, Kurokawa et al. disclose a system for transferring a digital image to a fulfillment center to generate a photographic product from said digital image comprising: Instructions for directing a first processing unit (Print service receiving server, of Fig. 1, page 1, paragraph 19) to: Maintain a list of a plurality of fulfillment centers available to generate a photograph from said digital image (Fig. 4, page 2, paragraph 28), Receive an order from said photographer processing unit (Step 48 of Fig. 2, page 2, paragraph 30), Transmit routing information to said photographer processing unit wherein said routing information is for transmitting said digital image to a fulfillment center processing unit of one of said fulfillment centers to process said order (page 2, paragraph 27), and Transmit said order to a fulfillment center processing unit of said one of said fulfillment centers (page 2, paragraph 29). Kurokawa et al. do not disclose expressly a media readable by said first processing unit that stores said instructions. It is inherent that the server of Kurokawa et al. includes a memory that stores the instructions performed by the server. RAM is an essential component for any server and stores the instructions that are performed. Kurokawa et al. do not disclose expressly receiving a request from a photographer processing unit for a list of options to generate a photographic product or transmitting to said photographer processing unit said list of options to said photograph product. Garfinkle et al. disclose receiving a request from a photographer processing unit for a list of options to generate a photographic product and transmitting to said photographer processing unit said list of options to said photograph processing unit (col. 7, lines 43-60). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital

photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to request a list of options and transmit the list of options for generating a photographic product to a user. The motivation for doing so would have been to let the user select the options from a predetermined list so that the user knows what options are available. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claim 1.

Referring to claims 2 and 45, Kurokawa et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: Receive said digital image from said photographer processing unit (page 2, paragraph 22).

Referring to claims 3 and 46, Kurokawa et al. disclose wherein said instructions to process said order further comprise: Instructions for directing said first processing unit to: Transmit said digital image to said fulfillment center processing unit (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 4 and 47, Kurokawa et al. disclose wherein said instructions for directing further comprise: Instructions for directing said first processing unit to: Receive a confirmation from said photographer processing unit responsive to said digital image being transmitted to said fulfillment center server (Step 49 of Fig. 2, page 2, paragraph 30).

Referring to claims 5 and 48, Kurokawa et al. disclose wherein said instructions for directing said first processing unit further comprise: Instructions for directing said first processing unit to: Determine said one of said fulfillment centers to process said order

from parameters received in said order (Step 45 of Fig. 2, page 2, paragraph 27) responsive to receiving said order (page 1, paragraph 19).

Referring to claims 6 and 49, Kurokawa et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: Receive a confirmation from said fulfillment center processing unit responsive to said order being processed (Step 48 of Fig. 2, page 2, paragraph 30).

Referring to claims 15 and 58, Kurokawa et al. disclose wherein said instructions to maintain said list of said fulfillment centers comprises: Instructions for directing said processing unit to: Maintain a web page listing said fulfillment centers (Fig. 4, page 2, paragraph 28) with hyper-link text pointing to web pages listing said options for said fulfillment centers (Fig. 5, page 2, paragraph 28). The options include the selection of a print order reception shop.

Referring to claims 16 and 59, Kurokawa et al. disclose instructions for directing a photographer processing unit (terminal 4 of Fig. 1, page 2, paragraph 26) to: Establish a connection with said first processing unit (Print service receiving server, of Fig. 1, page 1, paragraph 19), Receive said list of said fulfillment centers from said first processing unit (Fig. 4, page 2, paragraph 28), Display said list of fulfillment centers (Fig. 4, page 2, paragraph 28). and A second media readable by said photographer processing unit that stores said instructions (page 2, paragraph 25). Garfinkle et al. disclose Receive an input for said request for said list of options of said one of said fulfillment centers, Transmit said request to said first processing unit, receive said list of options, and Display said list of options (col. 7, lines 43-60).

Referring to claims 17 and 60, Kurokawa et al. disclose Instructions for directing said photographer processing unit to: Receive an input of said order (page 2, paragraph 24), and Transmit said order to said first processing unit (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 18 and 61, Kurokawa et al. disclose instructions for directing said photographer processing unit further comprise: Instructions for directing said photographer processing unit to: Receive said routing information from said first processing unit (Step 57 of Fig. 2, page 2, paragraph 27).

Referring to claims 19 and 62, Kurokawa et al. disclose instructions for directing said photographer processing unit to: instructions for directing said processing unit to: transmit said digital image to said first processing unit responsive to receiving said routing information (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 20 and 63, Kurokawa et al. disclose instructions for directing said photographer processing unit further comprises: Instructions for directing said photographer unit to: Transmit said digital image to said one of said fulfillment center processing unit using said routing information responsive to receiving said routing information (Step 47 of Fig. 2, page 2, paragraph 28).

Referring to claims 21 and 64, Kurokawa et al. disclose transmitting a digital image but does not disclose expressly transmitting a confirmation to said first processing unit responsive to transmitting said digital image. It would have been obvious to transmit a confirmation after a transmission of data. When a transmission occurs between two computers, a handshake is used to initialize and commence

communication. The motivation for doing so would be to alert the receiving computer that no further data is to be expected for the transmission.

Referring to claims 22 and 65, Kurokawa et al. disclose instructions for directing said photographer processing unit further comprise: Instructions for directing said photographer unit to: Transmit an account identification to said first processing unit responsive to transmitting said order (page 2, paragraph 26).

Referring to claims 23 and 66, Kurokawa et al. disclose ordering digital images, but do not disclose expressly a graphic instruction set. Garfinkle et al. disclose wherein said order includes a graphic instruction set for said photograph (col. 5, lines 20-29). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow a graphic instruction set for a photograph. The motivation for doing so would have been to allow customization of a photograph to the particular desires of a customer. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 23 and 66.

Referring to claims 24 and 67, Kurokawa et al. disclose wherein said request includes parameters for selecting said one of said fulfillment centers to process said order (Fig. 4, page 2, paragraph 28).

Referring to claims 25 and 68, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on location. Garfinkle et al. disclose wherein said parameters include a location of a fulfillment center (col. 9,

Art Unit: 2624

lines 34-37). It would be obvious for a location to be a parameter for selecting a fulfillment center because Garfinkle et al. discloses the customer picking up the photographs at the fulfillment center. Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based on location. The motivation for doing so would have been to select the closest or easiest fulfillment center from which to pick up photographs. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 25 and 68.

Referring to claims 26 and 69, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on size. Garfinkle et al. disclose wherein said parameters include sizes for said photographic product (col. 8, lines 39-67). Garfinkle et al. further discloses that size can be specified for ordering prints (col. 5, lines 20-29). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based on photo size. The motivation for doing so would have been to select a fulfillment center capable of providing photos in the desired size. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 26 and 69.

Referring to claims 27 and 70, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on graphics available.

Garfinkle et al. disclose wherein said parameters include graphics available for said photographic product (col. 5, lines 20-29). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based graphics available. The motivation for doing so would have been to select a fulfillment center capable of providing photos in the desired format. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 27 and 70.

Referring to claims 28 and 71, Kurokawa et al. disclose ordering digital images, but do not disclose expressly selecting a fulfillment center based on price. Garfinkle et al. disclose wherein said parameters include a range of prices for said photographic product (col. 8, lines 52-61). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to select a fulfillment center based prices. The motivation for doing so would have been to select a fulfillment center with the least expensive prices. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 28 and 71.

Referring to claims 29 and 72, Kurokawa et al. disclose Instructions for directing a fulfillment center processing unit (service shop of Fig. 1, page 1, paragraph 19) to: Receive said order from said first processing unit (page 1, paragraph 19), Receive said digital image (Step 48 of Fig. 2, page 2, paragraph 30), and Process said order to

generate said photographic product (page 2, paragraph 21); and A media readable by said fulfillment center processing unit that stores said instructions. It is inherent that the service shop of Kurokawa et al. includes a memory that stores the performed instructions. RAM is an essential component for any computer and stores the instructions that are performed.

Referring to claims 30 and 73, Kurokawa et al. disclose instructions for directing said fulfillment center processing unit further comprising: Instructions for directing said processing unit to: Store said digital image to a memory (page 2, paragraph 21).

Referring to claims 31 and 74, Kurokawa et al. disclose storing digital images in memory for processing but do not disclose expressly deleting said digital image from memory responsive to processing said order. It would have been obvious to clear the memory after printing said images because the images would need to be stored on RAM for processing and RAM needs to consistently delete memory to provide space for future processing.

Referring to claims 32 and 75, Kurokawa et al. disclose storing digital images in memory but do not disclose expressly deleting the images. Garfinkle et al. disclose Instructions for directing said fulfillment center processing unit to: Delete said digital image from said memory responsive to a period of time being reached (col. 5, lines 40-44). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art delete images after a certain time period. The motivation for doing so would have been to free up the space on the server

for other images. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 32 and 75.

Referring to claims 34 and 77, Kurokawa et al. disclose instructions for directing said fulfillment center processing unit further comprising: Instructions for said fulfillment center processing unit to: Transmit an availability of said one of said fulfillment centers to fulfill subsequent orders (page 2, paragraph 27).

Referring to claims 35 and 78, Kurokawa et al. disclose ordering digital images, but do not disclose expressly a graphic instruction set or generating a proof. Garfinkle et al. disclose generating a proof from said digital image and a graphic instruction set (col. 8, lines 13-19). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art generate a proof from a digital image and graphic instruction set. The motivation for doing so would have been to evaluate the images for errors before printing the order. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 35 and 78.

Referring to claims 36 and 79, Garfinkle et al. disclose instructions for directing said fulfillment center processing unit further comprises: Instructions for directing said fulfillment center processing unit to: Read said graphic instruction set from said order (col. 5, lines 20-29).

Referring to claims 37 and 80, Garfinkle et al. disclose instructions for directing said fulfillment center processing unit further comprises: Instructions for directing said

fulfillment center processing unit to: Receive said graphic instruction set from a photographer processing unit (col. 5, lines 20-29).

Referring to claims 38 and 81, Kurokawa et al. disclose instructions for directing said fulfillment processing unit further comprising: Instructions for directing said fulfillment center processing unit to: Receive said digital image from said first processing unit (page 2, paragraph 30).

Referring to claims 39 and 82, Kurokawa et al. disclose instructions for directing said fulfillment center processing unit further comprise: Instructions for directing said fulfillment center processing unit to: Receive said digital image from a photographer processing unit (page 2, paragraph 30).

Referring to claims 40 and 83, Garfinkle et al. disclose wherein said list of options includes photographic product sizes (col. 7, lines 43-60).

Referring to claims 43 and 86, Garfinkle et al. disclose wherein said list of options includes said fulfillment centers that provide particular options (col. 9, lines 8-13).

Referring to claim 44, Kurokawa et al. disclose a method for generating a photographic product from a digital image comprising the steps of: Maintaining a list of fulfillment centers available to generate said photographic product from said digital image (Fig. 4, page 2, paragraph 28) by a first processing unit (Print service receiving server, of Fig. 1, page 1, paragraph 19); Receiving an order from said photographer processing unit (Step 48 of Fig. 2, page 2, paragraph 30) from said photographer processing unit (terminal 4 of Fig. 1, page 2, paragraph 26); Transmitting routing information to said photographer processing unit wherein said routing information is for

transmitting said digital image to a one of said fulfillment centers to process said order (page 2, paragraph 27); and Transmitting said order to a fulfillment center processing unit of said one of said fulfillment centers (page 2, paragraph 29). Kurokawa et al. do not disclose expressly receiving a request from a photographer processing unit for a list of options to generate a photographic product or transmitting to said photographer processing unit said list of options to said photograph product. Garfinkle et al. disclose receiving a request from a photographer processing unit for a list of options to generate a photographic product and transmitting to said photographer processing unit said list of options to said photograph processing unit (col. 7, lines 43-60). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to transmit the list of options for generating a photographic product from the server to the photographer processing unit. The motivation for doing so would have been to let the fulfillment centers update their products centrally opposed to storing the options on the terminal. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claim 44.

7. Claims 7, 33, 41, 42, 50, 76, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640 and Garfinkle et al. U.S. Patent 6,017,157 as applied to claims 1 and 44 above, and further in view of Jackson et al. U.S. Patent 6,760,128.

Referring to claims 7 and 50, Kurokawa et al. disclose charging a fee for photographic products but do not disclose expressly debiting an account. Jackson et al. disclose debiting a photographer account responsive to receiving said order (col. 4, lines 42-46). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to keep an account for a photographer. The motivation for doing so would have been to have a system for billing a customer for goods provided. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 7 and 50.

Referring to claims 33 and 76, Kurokawa et al. disclose the fulfillment center processing unit and the first processing unit, but do not disclose expressly transmitting a status of the order periodically to the first processing unit. Jackson et al. disclose transmitting a status of said order periodically to said first processing unit (col. 9, lines 17-26). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to periodically transmit the status of an order to a terminal. The motivation for doing so would have been to notify the customer when the order is completed. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 7 and 50.

Referring to claims 41 and 84, Kurokawa et al. and Garfinkle et al. disclose a list of options but do not disclose expressly selecting a type of paper. Jackson et al. disclose a list of options includes types of paper available for said photographic product (col. 7, lines 11-13). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the customer to select a type of paper to print digital photos on. The motivation for doing so would have been to allow the customer to select a particular paper type according to a customer's preference. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 41 and 84.

Referring to claims 42 and 85, Kurokawa et al. and Garfinkle et al. disclose a list of options but do not disclose expressly graphics available to add to the image. Jackson et al. disclose a list of options includes graphics available to add to said digital image to generate said photographic product (col. 7, lines 13-15). Kurokawa et al. and Jackson et al. are combinable because they are from the same field of ordering digital photographs. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the customer to insert a graphic into a photograph. The motivation for doing so would have been to allow the customer to insert a date into a photograph. Therefore, it would have been obvious to combine Jackson et al. with Kurokawa et al. to obtain the invention as specified in claims 42 and 85.

8. Claims 8-11, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640, Garfinkle et al. U.S. Patent 6,017,157 and Jackson et al. U.S. Patent 6,760,128 as applied to claims 7 and 50 above, and further in view of Norris U.S. Patent 6,105,007.

Referring to claims 8 and 51, Jackson et al. disclose an account but do not disclose expressly receiving funds and crediting said account. Norris discloses receive a transfer of funds, and credit said funds to said account responsive receiving said funds are received (col. 14, lines 5-11). Norris and Kurokawa et al. are combinable because they are from the same field of money charging computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to transfer funds and credit an account. The motivation for doing so would have been to provide a means to deposit money into an account. Therefore, it would have been obvious to combine Norris with Kurokawa et al. to obtain the invention as specified in claims 8 and 51.

Referring to claims 9 and 52, Norris discloses wherein said funds are transferred electronically (col. 2, lines 62-65).

Referring to claims 10 and 53, Garfinkle et al. disclose wherein said instructions for transmitting said order to said fulfillment center processing unit are executed responsive to receiving said funds (5n and 5o of Fig. 5E, col. 9, lines 26-33). Kurokawa et al. and Garfinkle et al. are combinable because they are from the same field of ordering digital photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art receive funds before sending an order to a fulfillment

center. The motivation for doing so would have been to verify a customer has the required money before performing a service. Therefore, it would have been obvious to combine Garfinkle et al. with Kurokawa et al. to obtain the invention as specified in claims 10 and 53.

Referring to claims 11 and 54, Jackson et al. disclose wherein said instructions further comprise: Instructions for directing said first processing unit to: credit said funds received from said photographer to an account of said one of said fulfillment centers responsive to receiving said funds (col. 14, lines 5-11).

9. Claims 12-14 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa et al. Publication US 2001/0049640 and Garfinkle et al. U.S. Patent 6,017,157 as applied to claims 1 and 44 above, and further in view of Marwell et al. U.S. Patent 6,404,884.

Referring to claims 12 and 55, Kurokawa et al. disclose a service charge but do not disclose expressly charging periodically. Marwell et al. disclose periodically debiting a service charge to said account (col. 14, lines 45-49). Kurokawa et al. and Marwell et al. are combinable because they are from the same field of charging money for provided services. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to periodically charge a fee. The motivation for doing so would have been to deduct a monthly fee for unlimited use of the system. Therefore, it would

have been obvious to combine Marwell et al. with Kurokawa et al. to obtain the invention as specified in claims 12 and 55.

Referring to claims 13 and 56, Kurokawa et al. disclose maintaining a count of a number of orders (number of prints, page 2, paragraph 23).

Referring to claims 14 and 57, Marwell et al. disclose debiting a transactional charge for said order responsive to said count being above a predetermined number (col. 14, lines 45-49). The predetermined number disclosed by Marwell et al. is 1.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



DOUGLAS Q. TRAN
PRIMARY EXAMINER

